Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JAY PAUL DRUMMOND, DALE BLACKSON, BOB A. CICHON, JOSEPH C. ESS, MARK A. MOALES, DAVID W. WEIS, MARK D. SMITH, and JAMES CHURCH

Appeal No. 2003-1621
Application No. 09/193,564

ON BRIEF

Before RUGGIERO, BARRY, and BLANKENSHIP, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

REMAND TO EXAMINER

A patent examiner rejected claims 1-20. The appellants appealed therefrom under 35 U.S.C. § 134(a). We remand.

"The review authorized by 35 U.S.C. Section 134 is not a process whereby the examiner . . . invite[s] the [B]oard [of Patent Appeals and Interferences] to examine the application and resolve patentability in the first instance." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (Bd.Pat.App. & Int. 1999). In an *ex parte* appeal, "the Board is basically a board of review — we review . . . rejections made by patent examiners." *Ex*

parte Gambogi, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). Here, after considering the record, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Braeken*, 54 USPQ2d at 1112.

"An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action." (Paper No. 16 at 1-2 (citing M.P.E.P. § 1208 (8th ed., Aug. 2001)). Here, the examiner's second answer refers **indirectly** to more than one prior Office action.[1] Specifically, it references rejections "set forth in prior Office action, Paper No. 10." (Examiner's Answer at 3.) The referenced Office action, in turn, references rejections "set forth [in] the Office action mailed on 4/20/2001. . . ." (Final Rejection at 3.) Consequently, the examiner's answer **indirectly** refers to two Office actions.

When incorporating by reference, moreover, "[t]he page and paragraph of the final action or other single action which it is desired to incorporate by reference should be explicitly identified." M.P.E.P. § 1208. Here, the examiner's answer identifies neither the page nor paragraph of the actions it references.

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[1]The examiner's first answer was returned to him because it **directly** referred to two Office actions. (Paper No. 16.)

We "decline to substitute speculation as to the rejection for the greater certainty which should come from the [examiner] in a more definite [explanation] of the grounds of rejections." *Gambogi*, 62 USPQ2d at 1212. Instead, we ask the examiner to prepare a substitute examiner's answer that explains his rejections *in toto* rather than incorporating the rejections by reference.

CONCLUSION

For the above reasons, the application is remanded to the examiner for further action not inconsistent with the views expressed herein. Any subsequent answer submitted by the examiner should be self-contained with respect to all rejections and arguments. No prior answer should be referenced or incorporated therein. Similarly, any subsequent brief submitted by the appellants should be self-contained with respect to all arguments. No prior brief should be referenced or incorporated therein.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D). Accordingly, it requires immediate action. Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, reopening prosecution).

REMANDED

JOSEPH F. RUGGIERO)
Administrative Patent Judge)
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LANCE LEONARD BARRY) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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HOWARD B. BLANKENSHIP)
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